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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,260	11/02/2001	Roberto Perelman	07844-501001	5097
21876	7590	07/19/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. Box 1022 MINNEAPOLIS, MN 55440-1022			TIV, BACKHEAN	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/006,260	PERELMAN ET AL.
	Examiner Backhean Tiv	Art Unit 2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 April 2005.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-40 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-40 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 4/05.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

***Detailed Action***

Claims 1-40 are pending in this application. This is a response to the amendment filed on 4/29/05.

***Information Disclosure Statement***

The IDS filed on 4/29/05 has been considered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,026,433 issued to D'Arlach et al(D'Arlach) in view of US Patent 6,868,525 issued to Szabo.

As per claim 1, 16, 24, 32, D'Arlach teaches a machine-implemented method of modifying an electronic document(Abstract), the method comprising:  
receiving a request from a client(Abstract, Fig.2);  
producing data corresponding to the client request(Abstract, Fig.2);  
generating instructions to modify an electronic document defining visual information to be displayed(Abstract, Fig.4,8-14), the generated instructions specifying one or more operations to modify the electronic document at the client to accommodate

the produced data(Abstract, Fig.4), and the generated instructions including at least one tag indicating an order in which the produced data is to be imported into the electronic document and the instructions are to be performed(Abstract, Fig.4,6,8-14); and transmitting the produced data and the generated instructions to the client(Abstract) and the generated instructions to be performed at the client to effect the one or more operations(Abstract).

D'Arlach does not explicitly teach defining an appearance of the electronic document independent of a device used to present the electronic document.

Szabo teaches defining an appearance of the electronic document independent of a device used to present the electronic document(col.2, lines15-30; an XML document will appear the same no matter what platform the OS is).

Therefore it would have been obvious to one modify the teachings of D'Arlach to use a format that will appear the same no matter what platform the computer OS is as taught by Szabo in order to display the same data on any device.

One ordinary skilled in the art at the time of the invention would have been motivated to combine the teachings of Szabo and D'Arlach in order to provide a method so that a webpage can be displayed on all device no matter what OS the device is operating on.

As per claim 2, 33, wherein the produced data includes a location from which the client is to retrieve the electronic document(D'Arlach , Abstract, fig.2).

As per claim 3, 34 wherein the produced data includes a file name for the electronic document, which is already locally accessible by the client(D'Arlach, col.5, lines 46-55).

As per claim 4, 19,29,35, wherein the operations to modify the predetermined format at the client comprise adding information to the electronic document without changing pre-existing format information in the electronic document(D'Arlach, col.5, lines 46-55).

As per claim 5, 20,30,36 wherein the generated instructions comprise a script(D'Arlach, Fig.4).

As per claim 6, 21, 37, wherein the generated instructions further comprise at least one tag indicating an order in which the produced data is to be imported into the electronic document and the instructions are to be performed(D'Arlach, Fig.4, 7-13).

As per claim 7, 22, 38 wherein the at least one tag is a before tag, an after tag or a document tag, wherein the before tag indicates that the produced data is to be imported into the electronic document before the instructions are performed, the after tag indicates that the produced data is to be imported into the electronic document after the instructions are performed, and the document tag indicates that at least a portion of the generated instructions are to be inserted into the electronic document(D'Arlach, Fig.4, 7-13).

As per claim 8, 23,31,39, wherein the electronic document comprises a form document including one or more form fields, which are responsive to user actions(D'Arlach, Fig.4, 7-13).

As per claim 9, 40, wherein adding the information causes a new visual object to overlay one or more pre-existing visual objects in the electronic document(D'Arlach, Fig.4, 7-13).

As per claim 10, the method of claim 8, wherein the generated instructions are specific to the electronic document, and the operations to modify the predetermined format at the client result in one or more of the following document changes: field identity change, field location re-arrangement, and field content change(D'Arlach, Fig.4, 7-13).

As per claim 11, the method of claim 8, wherein the client comprises a device having a memory storing the electronic document(D'Arlach, Fig.2).

As per claim 12, the method of claim 8, wherein the client comprises a software application(D'Arlach, Fig.2).

As per claim 13, the method of claim 8, wherein the client request comprises a database search request, and wherein producing data comprises retrieving data from a database(D'Arlach, Abstract, Fig.2).

As per claim 14, the method of claim 8, wherein producing data comprises generating data using scripts(D'Arlach, Fig.4, 7-13).

As per claim 15, the method of claim 8, wherein generating instructions comprises: retrieving initial instructions(Abstract); and customizing the initial instructions to be specific to the electronic document(D'Arlach, Fig.4, 7-13).

As per claim 17, the method of claim 16, wherein obtaining the electronic document comprises receiving the electronic document(D'Arlach, Abstract).

As per claim 18, the method of claim 16, wherein obtaining the electronic document comprises retrieving the electronic document as directed by the instructions(D'Arlach, Fig.4, 7-13).

As per claim 25, the method of claim 24, wherein the at least one tag indicates that the produced data is to be imported into the electronic document before the instructions are performed(D'Arlach, Fig.4-13).

As per claim 26, the method of claim 24, wherein the at least one tag indicates that the produced data is to be imported into the electronic document after the instructions are performed(D'Arlach, Fig.4-13).

As per claim 27, the method of claim 24, wherein the at least one tag indicates that at least a portion of the generated instructions are to be inserted into the electronic document(D'Arlach, Fig.4-13).

As per claim 28, the method of claim 24, wherein the at least a portion of the generated instructions result in dynamically set preference settings for the electronic document(D'Arlach, Abstract, Fig.4-13).

Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,026,433 issued to D'Arlach et al(D'Arlach) in view of WO 00/51018 issued to Dilworth et al.(Dilworth).

As per claim 1, 16, 24, 32, D'Arlach teaches a machine-implemented method of modifying an electronic document(Abstract), the method comprising:

receiving a request from a client(Abstract, Fig.2);  
producing data corresponding to the client request(Abstract, Fig.2);  
generating instructions to modify an electronic document defining visual information to be displayed(Abstract, Fig.4,8-14), the generated instructions specifying one or more operations to modify the electronic document at the client to accommodate the produced data(Abstract, Fig.4), and the generated instructions including at least one tag indicating an order in which the produced data is to be imported into the electronic document and the instructions are to be performed(Abstract, Fig.4,6,8-14); and transmitting the produced data and the generated instructions to the client(Abstract) and the generated instructions to be performed at the client to effect the one or more operations(Abstract).

D'Arlach does not explicitly teach defining an appearance of the electronic document independent of a device used to present the electronic document.

Dilworth teaches defining an appearance of the electronic document independent of a device used to present the electronic document(Abstract).

Therefore it would have been obvious to one modify the teachings of D'Arlach to use a format that will appear the same no matter what platform the computer OS is as taught by Dilworth in order to display the same data on any device.

One ordinary skilled in the art at the time of the invention would have been motivated to combine the teachings of Dilworth and D'Arlach in order to provide a method so that a webpage can be displayed on all device no matter what OS the device is operating on.

As per claim 2, 33, wherein the produced data includes a location from which the client is to retrieve the electronic document(D'Arlach , Abstract, fig.2).

As per claim 3, 34 wherein the produced data includes a file name for the electronic document, which is already locally accessible by the client(D'Arlach, col.5, lines 46-55).

As per claim 4, 19,29,35, wherein the operations to modify the predetermined format at the client comprise adding information to the electronic document without changing pre-existing format information in the electronic document(D'Arlach, col.5, lines 46-55).

As per claim 5, 20,30,36 wherein the generated instructions comprise a script(D'Arlach, Fig.4).

As per claim 6, 21; 37, wherein the generated instructions further comprise at least one tag indicating an order in which the produced data is to be imported into the electronic document and the instructions are to be performed(D'Arlach, Fig.4, 7-13).

As per claim 7, 22, 38 wherein the at least one tag is a before tag, an after tag or a document tag, wherein the before tag indicates that the produced data is to be imported into the electronic document before the instructions are performed, the after tag indicates that the produced data is to be imported into the electronic document after the instructions are performed, and the document tag indicates that at least a portion of the generated instructions are to be inserted into the electronic document(D'Arlach, Fig.4, 7-13).

As per claim 8, 23,31,39, wherein the electronic document comprises a form document including one or more form fields, which are responsive to user actions(D'Arlach, Fig.4, 7-13).

As per claim 9, 40, wherein adding the information causes a new visual object to overlay one or more pre-existing visual objects in the electronic document(D'Arlach, Fig.4, 7-13).

As per claim 10, the method of claim 8, wherein the generated instructions are specific to the electronic document, and the operations to modify the predetermined format at the client result in one or more of the following document changes: field identity change, field location re-arrangement, and field content change(D'Arlach, Fig.4, 7-13).

As per claim 11, the method of claim 8, wherein the client comprises a device having a memory storing the electronic document(D'Arlach, Fig.2).

As per claim 12, the method of claim 8, wherein the client comprises a software application(D'Arlach, Fig.2).

As per claim 13, the method of claim 8, wherein the client request comprises a database search request, and wherein producing data comprises retrieving data from a database(D'Arlach, Abstract, Fig.2).

As per claim 14, the method of claim 8, wherein producing data comprises generating data using scripts(D'Arlach, Fig.4, 7-13).

As per claim 15, the method of claim 8, wherein generating instructions comprises: retrieving initial instructions(Abstract); and customizing the initial instructions to be specific to the electronic document(D'Arlach, Fig.4, 7-13).

As per claim 17, the method of claim 16, wherein obtaining the electronic document comprises receiving the electronic document(D'Arlach, Abstract).

As per claim 18, the method of claim 16, wherein obtaining the electronic document comprises retrieving the electronic document as directed by the instructions(D'Arlach, Fig.4, 7-13).

As per claim 25, the method of claim 24, wherein the at least one tag indicates that the produced data is to be imported into the electronic document before the instructions are performed(D'Arlach, Fig.4-13).

As per claim 26, the method of claim 24, wherein the at least one tag indicates that the produced data is to be imported into the electronic document after the instructions are performed(D'Arlach, Fig.4-13).

As per claim 27, the method of claim 24, wherein the at least one tag indicates that at least a portion of the generated instructions are to be inserted into the electronic document(D'Arlach, Fig.4-13).

As per claim 28, the method of claim 24, wherein the at least a portion of the generated instructions result in dynamically set preference settings for the electronic document(D'Arlach, Abstract, Fig.4-13).

### ***Response to Arguments***

All previous rejections are withdrawn due to applicant's amendments.

Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571)272-3941. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.***



Backhean Tiv  
2151  
7/15/05



ZARNI MAUNG  
SUPERVISORY PATENT EXAMINER